

REMARKS

The Applicants wish to thank the Examiner for a thorough consideration of the pending patent application. However, the Applicants respectfully traverse the Examiner's pending rejections for the reasons stated below.

Rejection Of Claims 1, 17 and 37 Under 35 U.S.C. §112(1).

Independent claims 1, 17 and 37 stand rejected under 35 U.S.C. §112, paragraph 1, for an alleged failure to comply with the written description requirement as to the following claim limitations:

- “prompting said plurality of inventors for invention disclosure approval”
- “performing a search to determine the state of the art associated with said invention disclosure . . . wherein said search is at least partially directed by at least one inventor of said invention disclosure”
- “allowing on-line access to the status of the invention disclosure, said status comprising where said invention disclosure is in a reviewing and *application filing process*.”

MPEP 2163.04 places the initial burden on the Examiner to present, by a preponderance of the evidence, reasons why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *See, In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976); *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).

The Office Action provided no evidence to support the written description rejection. Regardless, the disputed limitations find support in the application as filed. The first limitation, “prompting said plurality of inventors for invention disclosure approval,” is illustrated in Figure 2 (“SUBMISSION APPROVAL REQUEST” to “CO-INVENTORS” 54), Figure 3 (“NOTIFY INVENTORS TO APPROVE” 122 and “ALL INVENTORS APPROVE” 124), and is described in the specification (pages 9-10 and 13-14).

The second limitation, “performing a search to determine the state of the art associated with said invention disclosure . . . wherein said search is at least partially directed by at least one inventor of said invention disclosure” is illustrated in Figure 3 (“SEARCH” 109), the entirety of Figure 4 (“a flow chart of a search process according to the present invention”), and is described in the specification (pages 13 and 15-16). The inventor’s participation in the prior art search is described in the specification at page 13 (“the search may also interact with the inventor to determine whether the search is finding appropriate information”) and page 16 (“in step 208, the inventor may be prompted to provide a narrower search”).

The last limitation, namely invention disclosure status of “application filing process,” finds support in Figure 3 (“VIEW STATUS”) and in the specification at page 14 (“In step 130, all inventors are notified of the docket number. The inventors may view the status in step 132 of the docket.”).

Because the Office Action provides no evidence to support the written description rejection, and because the disputed limitations find support in the disclosure as filed, Applicants respectfully request withdrawal of the rejection of claims 1, 17 and 37 under 35 U.S.C. § 112, paragraph 1.

Rejection Of Claims 1-16 Under 35 U.S.C. §103(a).

Independent claim 1 stands rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,434,580 to Takano et al. in view of U.S. Pub. No. 2001/0039505 A1 to Cronin. The Examiner states at page 4 of the Office Action that Takano fails to teach or suggest the following limitation of independent claim 1:

allowing on-line access to the status of the invention disclosure, said status comprising where said invention disclosure is in a reviewing and application filing process.

To find this claim limitation in Cronin, the Examiner cites the abstract and certain paragraphs of the '505 Cronin non-provisional patent application. The '505 Cronin non-provisional patent application was filed on February 12, 2001 — after the Applicants' April 19, 2000 filing date. On page 3 of the Office Action, the Examiner identifies Cronin provisional patent application no. 60/179,675 for priority to February 2, 2000 — prior to the Applicants' filing date.

However, the '675 Cronin provisional patent application does not recite the passages of the '505 Cronin non-provisional patent application that the Examiner relies on to find the above claim limitation, and the Examiner does not cite any passage of the '675 Cronin provisional patent application to establish subject matter priority. The Applicants have reviewed the '675 Cronin provisional patent application, and find no teaching or suggestion of the claim limitation either.

Because *prima facie* obviousness has not been established for independent claim 1, or claims 2-16 which depend therefrom, the Applicants respectfully request withdrawal of the rejection of claims 1-16 under 35 U.S.C. § 103(a).

Rejection Of Claims 17-22 Under 35 U.S.C. §103(a).

Independent claim 17 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,434,580 to Takano et al. in view of U.S. Pub. No. 2002/0095368 A1 to TRAN, which claims priority to provisional patent application serial no. 60/185,644 filed February 29, 2000. The Examiner states at page 13 of the Office Action that

Takano fails to teach or suggest “prompting said plurality of inventors for invention disclosure approval” as recited in claim 17.

To find this claim limitation in TRAN, the Examiner cites paragraphs 40-41 and 43 of the ‘368 TRAN non-provisional patent application. The ‘368 TRAN non-provisional patent application was filed on April 25, 2001 — after the Applicants’ April 19, 2000 filing date. On page 12 of the Office Action, the Examiner identifies TRAN provisional patent application serial no. 60/185,644 for priority to February 29, 2000 — prior to the Applicants’ filing date.

However, the ‘644 TRAN provisional patent application does not recite the passages of the ‘368 TRAN non-provisional patent application that the Examiner relies on to find the above claim limitation, and the Examiner did not cite any passage of the ‘644 TRAN provisional patent application to establish subject matter priority.

Because *prima facie* obviousness has not been established for independent claim 17, or claims 18-22 which depend therefrom, the Applicants respectfully request withdrawal of the rejection of claims 17-22 under 35 U.S.C. § 103(a).

Rejection Of Claims 23-36 Under 35 U.S.C. §103(a).

Independent claim 23 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,434,580 to Takano et al. in view of U.S. Patent No. 6,339,767 to Rivette. At page 17 of the Office Action, the Examiner states that Takano does not teach the following limitations of independent claim 23:

prompting the user for classification information, which refers to a technology area; and

notifying an evaluator in response to the classification information.

The Examiner cites Rivette at col 18, lines 55-57, col.60, lines 3-18, and col. 93, lines 1-20 to find these limitations. These passages of Rivette describe databases for storing “bibliographic” data associated with *existing* patents, such as patent numbers, issue dates, inventors, titles, etc., as well as the classifications provided on the face of those already-issued patents. Rivette is directed to the analysis of existing patents in view of certain “non-patent information of interest to a corporate entity.” (Summary Of The Invention, col. 4, lines 1-9.) The Rivette system “automatically process[es] patent-related information and non-patent related information for making corporate business decisions.” (Background Of The Invention, col. 3, lines 62-62.)

Rivette does not relate to the preparation of invention disclosures, and does not teach or suggest prompting a user for classification information, which refers to a technology area, or notifying an evaluator in response to the classification information. In Rivette, there is simply no need for the user to input classification information, or for an evaluator to evaluate it, because the patents described in Rivette have already issued.

Because Rivette does not teach or suggest prompting the user for classification information referring to a technology area, or notifying an evaluator in response to the classification information, one of ordinary skill in the art would not have been motivated to combine Takano with Rivette, and the proposed combination would not result in the recited invention.

Because *prima facie* obviousness has not been established for independent claim 23, or claims 24-36 which depend therefrom, the Applicants respectfully request withdrawal of the rejection of claims 23-36 under 35 U.S.C. § 103(a).

Rejection Of Claims 37-41 Under 35 U.S.C. §103(a).

Independent claim 37 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,434,580 to Takano et al. in view of U.S. Patent No. 6,339,767 to Rivette. At page 20 of the Office Action, the Examiner states that Takano does not teach the following limitations of independent claim 37:

performing a search to determine the state of the art associated with said invention disclosure; and

wherein said search is at least partially directed by at least one inventor of said invention disclosure.

The Examiner cites the following passages from Rivette to find these limitations: Figures 40-44, col 2, lines 42-55, col.28, lines 1-14, and col. 54, lines 18-60. But, as explained above, the entire Rivette specification is directed to the analysis of existing patents in view of certain “non-patent information of interest to a corporate entity.” (Summary Of The Invention, col. 4, lines 1-9.) The Rivette system “automatically process[es] patent-related information and non-patent related information for making corporate business decisions.” (Background Of The Invention, col. 3, lines 62-62.) Rivette does not relate to the preparation of invention disclosures, and expressly teaches away from prior art searching in connection with invention disclosure preparation, as recited in claim 37:

The present invention, upon receiving appropriate operator commands, automatically processes the patents in one or more of the groups in conjunction with **non-patent information** from the second databases.

(Summary Of The Invention, col. 4, lines 6-9.)

Rivette describes searching the patent database based on information that is **un**related to patent information. In this fashion, one of skill in the art would have been discouraged from combining Rivette with Takano. MPEP 2145 (“It is improper to combine

references where the references teach away from their combination”) citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Regardless, both Takano and Rivette fail to teach or suggest a prior art search being directed by an inventor of the invention disclosure. This aspect of the claimed invention may result in an improvement in the overall quality of the prior art search, because inventors are often familiar with the relevant terminology used by those of skill in the art to which the invention disclosure pertains.

Because *prima facie* obviousness has not been established for independent claim 37, or claims 38-41 which depend therefrom, the Applicants respectfully request withdrawal of the rejection of claims 37-41 under 35 U.S.C. § 103(a).

Conclusion

The Applicants appreciate the Examiner’s attention to this patent application, and have made a genuine attempt to respond to each of the Examiner’s arguments giving rise to the pending rejections. The Examiner is invited to contact the Applicants’ undersigned

counsel telephonically, or to request an interview, if that would help to advance the prosecution of this application.

The Director is hereby authorized to charge the RCE fee required under 37 C.F.R. § 1.17(e) in the amount of \$790.00, the three-month extension of time petition fee under 37 C.F.R. § 1.136(a) in the amount of \$1,020.00, and any additional fees or credit any overpayments as a result of the filing of this paper to Deposit Account No. 02-3978.

Respectfully submitted,

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Date: December 27, 2006

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